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EXAMINER

PREBILIC, PAUL B

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 06/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/418,505

Applicant(s)

KANIA ET AL.

Examiner

Paul B. Prebilic

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 1-15, 21, 22, 29 and 32 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18-20 is/are allowed.
- 6) ☒ Claim(s) 16, 17, 23-28, 30, 31 and 33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

***Election/Restrictions***

Claims 1-15, 21, 22, and 29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention or species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 11 filed December 14, 2001.

Newly submitted claim 32 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The covering coated on the outside with a different polymeric material is distinct from the originally presented inventions because at least it is to a combination that is distinct from the subcombination claimed in the other claims. This is due to the fact that the properties of the fabric and polymeric material are claimed more specifically in the subcombination than in the combination

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 32 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Inventorship***

In view of the papers filed March 3, 2000, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48(a). The inventorship of this application has been changed by adding Christopher Kelly as the sixth inventor.

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The application is still due to be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of the file jacket and PTO PALM data has been made to reflect the inventorship as corrected.

### ***Specification***

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on March 27, 2002 have been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 24, 25, and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 24, the claim language "docking means for suspension of the covering to the wearer" appears to lack antecedent basis from the specification such that it is not clear what element thereof is being discussed. For this reason, the Examiner will interpret this language as referring to Figure 9 and similar structures of the specification.

With regard to claim 25, the language "docking means for attaching pads" lacks antecedent support from the specification and it is unclear what element(s) of the

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specification are being referred to. For this reason, the Examiner will interpret claim 25 as referring to structures such as those shown in Figure 9.

With regard to claim 30, original implicit support can be found for the subject matter set forth herein, the Examiner notes that there is no clear antecedent basis from the specification for the subject matter of this claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 16, 17, 23-25, 27, 30, 31, and 33 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Kania (US 5,830,237); see the whole document, especially Figures 9 and 11.

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With regard to claims 16 and 17, the elastic fabric of Kania is wear resistant and highly elastic to the extent that these terms can be given patentable weight due to the relativity. For this reason, even if the same fabric were used for both the pieces of fabric, the claim language would be fully met because the some of the fabrics have both claimed properties to some degree.

With regard to claim 30, the Examiner posits that at least the terry fabrics can adhere to hook and loop fasteners because they have loops on the surface. Other fabrics disclosed have this property to some extent, but terry fabric appears to be the best of the disclosed fabrics; see Example 7 of Kania.

Claim 23, 31, and 33 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Kania (US 5,603,122); see the whole document.

Claims 24, 31, and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Lerman (US 4,635,626); see the whole document, especially Figures 5 and 6 where fabric on the inner and outer polymer material surface reads on the claimed invention; see column 6, line 55 et seq.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lerman (US 4,635,626) in view of Laghi (US 5,507,834). Lerman meets the claim language but

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does not disclose the use of a thermal-regulating additive as claimed. Laghi, however, teaches that it was known to use silica fillers in similar coverings in order to improve the viscosity of the polymeric material. Since this additive would also change the thermal properties of the polymeric material because it would make it denser, the Examiner asserts that the silica fillers are thermal-regulating additives to the extent that this terminology can be given weight. Hence, it is the Examiner's position that it would have been obvious to add silica fillers to the Lerman polymeric material in order to improve the viscosity thereof and for the other reasons that Laghi does the same.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lerman (US 4,635,626) in view of Kristinsson et al (US 6,136,039). Lerman meets the claim language except for the metal coating on the outside as claimed. Kristinsson et al teaches that it was known to use docking means, which are usually made of metal, to the outside of similar covering devices. Kristinsson, however, does not disclose expressly the use of a metal docking means. Nonetheless, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to use metal as the docking means material because Applicant has not disclosed that using metal provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with metal because it is a strong durable material which can withstand the rigors of long-term use. Therefore, it

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would have been an obvious matter of design choice to modify Kristinsson to obtain the invention as specified in claim.

Additionally, since coatings are denoted in dictionaries to encompass coverings, the docking means of Kristinsson et al constitutes a coating. Hence, it is the Examiner's position that it would have been obvious to add a docking means, or metal coating, to the Lerman device in order to facilitate its secure attachment to a leg prosthesis.

***Allowable Subject Matter***

Claims 18 to 20 are allowed over the prior art of record.

***Response to Arguments***

Applicant's arguments filed March 27, 2002 have been fully considered but they are not persuasive.

In response to the traversal of the claim 30 Section 112 rejection, the Examiner asserts that the specification should explicitly state that the jersey knit or terry knit fabrics can adhere to hook portions of VELCRO. This is due to the fact that this subject matter is essential to the claimed invention. For this reason, the first paragraph rejection of Section 112 has been withdrawn, but not the second paragraph rejection.

In the traversal of the claims 24 and 25 rejection under Section 112, Applicants argue that the docking means is set forth on pages 17 and 18 of the specification. However, upon review of these pages, the Examiner maintains that the claim language is indefinite. In particular, claim 24 sets forth a "docking means for suspension of the covering to the wearer." (emphasis added) The Examiner does not disagree that there



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are docking means disclosed in the specification. However, the Examiner cannot find support for docking means "for suspension of the covering to the wearer", and he cannot understand what is intended to be claimed in the context of the present invention.

With regard to claim 25, the claim language is still considered indefinite because docking mean for the pads of pages 17 and 18 are on the inside of the covering and are to contact the stump or socket. However, what is claimed and what is shown in Figure 12 are to docking means on the outside of the covering.

With respect to the traversal of the claims 16 and 17 rejection under 35 USC 102 with Kania ('237), the Examiner asserts that the "higher wear resistant" and "lower wear resistant" fabrics are not in comparison to each other so they only need to be different from each other. Kania teaches using different fabrics in different areas so the claim language is fully met; see column 8, lines 11-19.

In response to the argument that there is no docking means in Kania ('237), the Examiner posits that there are docking means shown at least in Figure 9.

Applicants argue that Kania does not have any fastening system of hook and loop of claim 30. However, the Examiner asserts that claim 30 only requires a fabric that can adhere to a hook portion of a hook and loop fastening system. Since Kania discloses terry and jersey knit fabrics with loops on the surface, the claim language is fully met in this regard.

In the traversal of the claim 23 rejection, Applicants argue that there is no fiber-on-end fabric disclosed thereby. The Examiner notes that the fiber-on-end fabric

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definition only requires fibers with vertically protruding fibers; see page 28, lines 9-12 of the specification. The Examiner asserts that at least the jersey knit (column 9, line 8 of Kania), looped nylon (column 9, line 43), and terry fabric (Example 7) have this property and meet the claim language. Furthermore, numerous other fabrics are incorporated into the disclosure by reference to other document. The incorporated documents may also contain cut pile and other fabrics with vertically protruding fabrics. For this reason, the "fiber-on-end" fabric limitation is considered to be fully met.

In response to the traversal of claim 26, the Examiner posits that Laghi need not add silica filler for the same reason as Applicants to obviate the claims. Furthermore, the arguing that Laghi has different other features constitutes a piecemeal analysis of the references which does not appreciate the teaching of one to the other.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned problem is corrected.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Prebilic whose telephone number is (703) 308-2905. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for this Technology Center is (703) 872-9301.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 3700 receptionist whose telephone number is (703) 308-0858.



Paul Prebilic  
Primary Examiner  
Art Unit 3738